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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,727	11/07/2005	Jon Christian Soper	GIV.P30054	2030
23575 7590 11/12/2009 CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145				
EXAMINER				
CHAWLA, JYOTI				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/555,727

Applicant(s)

SOPER ET AL.

Examiner

JYOTI CHAWLA

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's submission filed on 7/6/2009 has been entered as compliant. Claims 1-20 are pending and examined in the current application.

Claim Objections

Claim 9 is once again objected to because of the following informalities: spelling of "colouring matter" are not acceptable US spellings. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(1) Claim 1-5, 8, 10-12, 15-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cherukuri (US 5266335).

References and rejections are incorporated herein and as cited in the previous office action dated 3/3/2009.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 7, 13-14, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri (US 5266335).

Cherukuri has been applied to claims 1-5, 8, 10-12, 15-16 and 20 under 35 USC 102(b) as discussed above.

References and rejections are incorporated herein and as cited in the previous office action dated 3/3/2009.

(B) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri, in view of Huzinec (US 5912030).

Cherukuri has been applied to claims 1-5, 8, 10-12, 15-16 and 20 under 35 USC 102(b) as discussed above.

References and rejections are incorporated herein and as cited in the previous office action dated 3/3/2009.

(C) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri, in view of Merritt et al (US 4515769), hereinafter Merritt.

Cherukuri has been applied to claims 1-5, 8, 10-12, 15-16 and 20 under 35 USC 102(b) as discussed above.

References and rejections are incorporated herein and as cited in the previous office action dated 3/3/2009.

Double Patenting

The nonstatutory double patenting rejections made in the previous office action over claims 1 and 6 of U.S. Patent No. 6325951 B1 and over claims 1, 6, 9, 11, 12, 13, 16, 20, 21, 23-25 and 28 of U.S. Patent No. 6106875 have been withdrawn based on applicant's arguments dated 7/6/2009 (Remarks, pages 14-18).

Response to Arguments

Applicant's arguments filed 7/6/2009 have been fully considered but they are not persuasive.

i) Applicants argue that "Cherukuri et al. do not disclose matrix particles containing a plurality of inclusions of oil" (See remarks, page 7, lines 9-13 and page 9, lines 1-5, date 7/6/2009) Applicants support this argument by stating that "Cherukuri et al rather disclose capsules that contain merely one oil core surrounded by a wall". Applicant's argument is not persuasive because Cherukuri teaches of Matrix particles comprising a discontinuous phase of a plurality of inclusions of oil, wherein the oil is optionally flavor oil or fragrance oil (Column 4, lines 16-21, Figure 1).

ii) Applicants' further argue that a "definition of a filler provided by applicant's specification" and also argue that "Cherukuri does not specify provision of a filler" (See remarks, page 7, lines 17-20 and page 8, lines 1-9 of 7/6/2009). This argument is also not persuasive because applicant's specification does not provide a specific definition for filler. The disclosure provides examples by disclosing "Fillers for polymeric materials are well known in the plastics art. They are generally cheap, readily-available organic and inorganic materials, used to extend the materials and reduce costs." (Emphasis added) (See Specification, page 3, lines 22 -25). The specification further provides example that "preferred filler is microcrystalline cellulose (MCC). Applicant's disclosure further clarifies that "microcrystalline cellulose ... disperses in water and has the properties of a gum." (Specification, page 4, lines 4 and 20-21) and that "MCC may be replaced by or mixed with other fillers that are inert, essentially insoluble and essentially do not swell, and are capable of forming a dispersion of solid particles in water. These materials include non-starch polysaccharides, celluloses, modified starches, and other polymers, including proteins." (Specification, page 4, lines 26-29). Thus, based on the general examples in applicants' disclosure a gum, cellulose polymer or microcrystalline cellulose or derivative thereof constitutes filler (Specification, page 3, lines 28-29). In

addition applicants' independent claim recites "and at least one filler" and dependent claim 4 recites "comprising a filler selected from the group consisting of inorganic substances, organic substances, and combinations thereof". Cherukuri teaches of gum, carboxymethyl cellulose (a derivative of microcrystalline cellulose) and polymers, i.e., fillers as claimed (See column 6, lines 27-35).

iii) Applicants' argument about the obviousness rejection of claims 7, 17-19 over Cherukuri is based on applicant's conclusion that "Cherukuri fails to provide any reference to "surface oil" whatsoever" (Remarks, page 10, line 15). This argument is also not persuasive because, first of all, applicant has defined surface oil as "By "surface oil" is meant an undesirable concentration of oil occurring at the surface of particles" (Specification, Page 1, lines 25-26) and "Surface oil" is the weight percent of the sample that is oil which may be extracted from the sample by a simple solvent wash of the sample in a reagent that is non-intrusive to the sample matrix particles." (Specification, Page 2, lines 5-8). Regarding the surface oil, Cherukuri teaches that the size of the pores in the walls of microcapsules may be controlled by the rate of gelling process, such that if the emulsion is rapidly cooled and gelled the resulting matrix of microcapsules will have a pore size so small that the encapsulated oil will not escape through the capsule walls (Column 6, line 65 to Column 7, line 5). Cherukuri also teaches that after the particles are made, water and anticaking agent are added and the microcapsules are washed 4 times, filtered and then dried (Column 21, lines 1-8). Thus, Cherukuri teaches of making the microcapsules as recited in claim 1 and in a manner such that no oil escapes and the surface oil is removed with the help of water and anticaking agent, i.e., no surface oil. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that Cherukuri teaches of no or low surface oil. One of ordinary skill would have been motivated to modify Cherukuri and disclose the amount of surface oil at least for the purpose of quantifying the level of excess oil contained in the matrix. One would have been further motivated to quantify the amount of surface oil in an encapsulated matrix at the time of preparation and

several times during storage to determine the storage stability of the matrix comprising the flavor oil.

Further, it is noted that the applicant has described the product with parameters and equations which cannot be measured by the office for prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability purposes. Therefore, as a prima facie case of obviousness has been properly established, the burden is shifted to the applicant to show that the prior art product is different.

iv) Applicant's argument against obviousness rejection over Cherukuri, in view of Huzinec is "Cherukuri et al. do not disclose or suggest matrix particles comprising MCC as claimed" (Remarks, page 11, paragraph 4, line 3). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants further argue that Cherukuri and Huzinec do not teach the claimed subject matter by stating that "this combination of references does not show all the claimed features of claim 6" (Remarks, page 11, last 3 lines). This argument is not persuasive because Cherukuri teaches the invention as claimed in independent claim 1 (as discussed above) and Huzinec is being relied upon to show that it was known to use microcrystalline cellulose (Column 2, lines 15-19) which can be mixed with additives, such as, flavors, flavor enhancers, flavor masking additives, sweeteners, sweetener enhancers, vitamins, pharmaceuticals, minerals, colors, acids, and mixtures thereof and also for encapsulated additives (Column 2, lines 32-40 and Column 3, lines 38, 54-58). Huzinec also teaches that the carrier, such as, Microcrystalline cellulose (MCC) has a property where more than one additives can be added to the carrier and each additive can be released either at the same time or at different times (Column 2, lines 8-13). Further it is noted that MCC works as a filler, binder, and flow aid and anticaking agent and as suspension stabilizer, and emulsifier (Dictionary of Food Ingredients). Therefore,

it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cherukuri in view of Huzinec and add microcrystalline cellulose to the matrix comprising the encapsulated flavor. One of ordinary skill would have been motivated to modify Cherukuri at least for the purpose of producing an encapsulated flavor matrix comprising one or more encapsulated active ingredient or oil/ flavor oils wherein the matrix particles remain stable and have a delayed release property.

v) Applicants' argument regarding Cherukuri in view of Merritt (Remarks, pages 13-14) is based on Cherukuri not teaching the invention as claimed in independent claim 1, which has been addressed above.

Cherukuri is silent as to the matrix particles comprising coloring matter. Merritt teaches of encapsulated flavorant material comprising coloring material (Column 11, lines 17-20). Thus encapsulated particles comprising coloring matter were known at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cherukuri in view of Merritt and add coloring matter to the encapsulated flavor particle. One of ordinary skill would have been motivated to modify Cherukuri at least for the purpose of producing an encapsulated flavor and a composition containing such flavor with interesting appearance (Merritt Column 11, line18-20).

vi) Applicants' argument that "the resins disclosed in Cherukuri et al are added to the oil and not to the polymer matrix" (Remarks, page 8, paragraph 2, line 3) is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., resins not added to the polymer matrix) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, claims 1-20 remain rejected for reasons of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/
Examiner
Art Unit 1794

/Keith D. Hendricks/
Supervisory Patent Examiner, Art Unit 1794